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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,574	04/23/2001	Marston Manthorpe	1530.0180002/EKS/EJH	1437

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[REDACTED] EXAMINER

SCHNIZER, RICHARD A

ART UNIT	PAPER NUMBER
1635	6

DATE MAILED: 02/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

	Application No.	Applicant(s)
	09/839,574	MANTHORPE ET AL.
Examiner	Art Unit	
Richard Schnizer	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM

### THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-163 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) \_\_\_\_ is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) 1-163 are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1-37, 54-87, 106-141, and 159-163 drawn to compositions comprising about 1 ng to about 30 mg of a nucleic acid encoding a polypeptide, and a salt or auxiliary agent, classified in class 536, subclass 23.1.
- II. Claims 38-53, 88-105, 142-158, drawn to methods of delivering a polypeptide to a vertebrate by administration of a polynucleotide encoding the polypeptide, classified in class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method of group II requires delivery of the composition in vivo to a vertebrate. More particularly claims 40, 89, and 143 require resulting immune responses or therapeutic effects. However one of ordinary skill in the art appreciates that the compositions could be used for the expression of a polypeptide in vitro, as classified in class 325, subclass 69.1. thus the

claimed composition can be used in patentably distinct processes, and restriction is proper.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and their recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

***Election of Species***

Claims 1-163 are generic to a plurality of disclosed patentably distinct species comprising salts selected from the group consisting of sodium acetate, sodium bicarbonate, sodium sulfate, potassium phosphate, potassium acetate, potassium bicarbonate, potassium sulfate, sodium glycero-phosphate, and sodium glucose-6-phosphate. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Claims 1-163 are generic to a plurality of disclosed patentably distinct species comprising polypeptides which may be encoded by a polynucleotide. For example claim 21 lists types of Applicant must elect a single polypeptide from the polypeptides listed in claim 22, or claim 26, or the polypeptides disclosed in paragraphs 133-140 of the specification. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Claims 1-163 are generic to a plurality of disclosed patentably distinct species comprising transfection facilitating agents selected from the group consisting of cationic

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lipids, calcium phosphate, alum , gold, tungsten, peptides, proteins, and polymers.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Claims 1-163 are generic to a plurality of disclosed patentably distinct species comprising auxiliary agents selected from the group consisting of surfactants, detergents, polysaccharides, chelators, DNase inhibitors, listed in specification paragraphs 96-98, 100, 101 or claims 29-31. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Claims 1-163 are generic to a plurality of disclosed patentably distinct species comprising delivery routes or locations as listed in claims 44, 45, and 50. Applicant is required under 35 U.S.C. 121 to elect a single disclosed delivery route or location, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Richard Schnizer, whose telephone number is 703-306-5441. The examiner can normally be reached Monday through Friday between the hours of 6:20 AM and 3:50 PM. The examiner is off on alternate Fridays, but is sometimes in the office anyway.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Leguyader, can be reached at 703-308-0447. The FAX numbers for art unit 1632 are 703-308-4242, and 703-305-3014. Additionally correspondence can be transmitted to the following RIGHTFAX numbers: 703-872-9306 for correspondence before final rejection, and 703-872-9307 for correspondence after final rejection.

Inquiries of a general nature or relating to the status of the application should be directed to the Patent Analyst Trina Turner whose telephone number is 703-305-3413.



Richard Schnizer, Ph.D.